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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

KIDWELL, MICHELE M

ART UNIT	PAPER NUMBER
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3761

DATE MAILED: 02/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/026,122

Applicant(s)

DATTA ET AL.

Examiner

Michele Kidwell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 18-21 and 37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 22-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 December 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/1/02; 11/25/02; 7/21/03; 11/3/03; 10/10/03
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of species 1 in the reply filed on August 3, 2004 is acknowledged.

Claims 18 – 21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on August 3, 2004.

Claim 37 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim.

Claim 37 is directed to a pleated tissue wrap, which is not depicted by the species elected by applicant.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the spacer material, the surge layer, the extensible spacer layer, the waist size adjustment means, and a pleated tissue wrap must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is

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being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "32" and "52" have both been used to designate a waist edge. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

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The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: reference characters "72" and "74" are not mentioned in the description. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 29 – 36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 29, the applicant claims that at least one secondary component provides an “additional fit range” in lines 8 – 9 of the claim. The scope of the claim is unclear since a first fit range has not been disclosed. It is unclear what the applicant intends to claim as an invention.

Where the metes and bounds of a claim are indefinite, it is improper to base a rejection on speculation as to the meaning of the claim. In re Steele, 305 F.2d 858, 134 USPQ 292 (CCPA 1962). Specifically, unclear claims are indefinite, not obvious. In re Wilson, 424 F.2d 1382, 185 USPQ 494 (CCPA 1970).

Accordingly, these claims have not been further treated on the merits.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 – 6, 16 – 17, 22 – 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Ando et al. (US 5,370,634).

With respect to claims 1 and 2, Ando et al. (hereinafter “Ando”) discloses a prefastened, refastenable absorbent article, comprising: an outer cover extensible in a lateral direction of the prefastened absorbent article and

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having a moisture barrier; a bodyside liner at least partially bonded to the outer cover and extensible in the lateral direction; and an absorbent core positioned between the outer cover and the body side liner; the outer cover, bodyside liner and the absorbent core defining a chassis having a waist opening, wherein the prefastened absorbent article has a percent fit range of at least about 33% as set forth in col. 4, lines 11 – 26 and in the figures.

The examiner contends that the claimed percent fit range is a product by process limitation that does not lend anything structurally to the claim. The applicant is reminded that:

"[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted).

As to claim 3, Ando discloses a prefastened absorbent article further comprising an elastic fit panel (10) attached to the chassis as set forth in figure 1.

With reference to claim 4, Ando discloses a prefastened absorbent article wherein the chassis further comprises an elastic first side panel (14) and a laterally opposing elastic second side panel (14) as set forth in figures 1 – 2.

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Regarding claim 5, Ando discloses a prefastened absorbent article further comprising a first fastener (6) bonded to the first side panel and a laterally opposing second fastener (6) bonded to the second side panel as set forth in figures 1 – 2.

With respect to claim 6, Ando discloses a prefastened absorbent article further comprising at least one attachment panel (8) attached to a front waist region of the absorbent article, wherein each of the first fastener and the second fastener are releasably attached to the attachment panel as set forth in col. 6, lines 38 – 41.

As to claims 16 and 17, Ando discloses a prefastened absorbent article comprising a diaper and/or training pants as set forth in the figures.

With reference to claim 22, Ando discloses a prefastened absorbent article, comprising: a chassis having a front waist region, a back waist region and a crotch region intermediate the front waist region and the back waist region, the chassis defining a waist opening; an outer cover having a moisture barrier; a bodyside liner at least partially bonded to the outer cover; and an absorbent core positioned between the outer cover and the bodyside liner as set forth in col. 4, lines 11 – 26 and in the figures.

Regarding claim 23, Ando discloses a prefastened absorbent article wherein the chassis comprises an elastic material as set forth in col. 2, lines 31 – 48.

Claims 1 – 3, 10 – 12, 15 – 17, 22 – 23 and 26 – 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Arndt et al. (WO 99/55265).

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With respect to claims 1 and 2, Arndt et al. (hereinafter "Arndt") discloses a prefastened, refastenable absorbent article, comprising: an outer cover extensible in a lateral direction of the prefastened absorbent article and having a moisture barrier; a bodyside liner at least partially bonded to the outer cover and extensible in the lateral direction; and an absorbent core positioned between the outer cover and the body side liner; the outer cover, bodyside liner and the absorbent core defining a chassis having a waist opening, wherein the prefastened absorbent article has a percent fit range of at least about 33% as set forth on page 9, 1st paragraph.

The examiner contends that the claimed percent fit range is a product by process limitation that does not lend anything structurally to the claim. The applicant is reminded that:

"[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted).

As to claim 3, Arndt discloses a prefastened absorbent article further comprising an elastic fit panel attached to the chassis as set forth on page 9, 1st paragraph.

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With reference to claims 10 and 26 – 27, Arndt discloses a prefastened absorbent article of claim 1, further comprising a spacer material at least partially bonded to the outer cover as set forth on page 71, 1st full paragraph.

With reference to claims 11 – 12, Arndt discloses a prefastened absorbent article further comprising at least one extensible containment flap positioned along a first side edge of the prefastened absorbent article and a second extensible containment flap positioned along a laterally opposing second side edge of the prefastened absorbent article as set forth on page 9, 1st paragraph.

As to claim 15, Arndt discloses a prefastened absorbent article further comprising a surge layer, the surge layer one of elastic and extensible in a lateral direction of the prefastened absorbent article as set forth on page 70, last paragraph.

As to claims 16 and 17, Arndt discloses a prefastened absorbent article comprising a diaper and/or training pants as set forth in figure 1.

With reference to claim 22, Arndt discloses a prefastened absorbent article, comprising: a chassis having a front waist region, a back waist region and a crotch region intermediate the front waist region and the back waist region, the chassis defining a waist opening; an outer cover having a moisture barrier; a bodyside liner at least partially bonded to the outer cover; and an absorbent core positioned between the outer cover and the bodyside liner as set forth on page 9, 1st paragraph.

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Regarding claim 23, Arndt discloses a prefastened absorbent article wherein the chassis comprises an elastic material as set forth on page 9, 1st paragraph.

With reference to claim 28, see the rejection of claims 1, 10 – 12 and 15.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7 – 9, 13 – 14, 24 and 25 rejected under 35 U.S.C. 103(a) as being unpatentable over Ando et al. (US 5,370,634).

The difference between Ando and claim 7 is the provision that the attachment panel comprises a loop material, which is extensible in a lateral direction.

Ando provides a tape fastener as opposed to a hook and loop type fastener as set forth in col. 4, lines 29 – 37.

It would have been obvious to modify the fastener of Ando by providing a hook and loop type fastener instead of a tape fastener since the substitution of one fastener for another is within the level of one of ordinary skill in the art.

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With respect to claim 8, Ando teaches a first fastener and the second fastener are laterally separated by at least about 2.0 inches with respect to the attachment panel as set forth in col. 10, lines 12 – 36.

As to claim 9, Ando teaches an attachment panel that is passively bonded to a back waist region of the absorbent article as set forth in col. 7, line 67 to col. 8, line 16.

As to claims 13 and 14, see the rejections of claims 7 and 8.

The difference between Ando and claim 24 is the provision that the outer cover and the bodyside liner are one of elastic and extensible in a certain direction.

Ando discloses an outer cover and the bodyside liner that are one of elastic and extensible as set forth in col. 5, lines 30 – 54.

Absent a teaching of criticality and/or unexpected result, the examiner contends that the direction in which the materials are one of elastic and extensible is an obvious matter of design choice that does not patentably distinguish the claimed invention from the prior art.

As to claim 25, see the rejection of claim 24.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michele Kidwell whose telephone number is 571-272-4935. The examiner can normally be reached on Monday - Friday, 5:30am - 2:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Schwartz can be reached on 571-272-4390. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Michele Kidwell
Examiner
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